



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1400  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,559	12/19/2000	Bridget D. Kimball	18926-003500US	4506
20350	7590	03/06/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/740,559	Applicant(s) KIMBALL ET AL.	
	Examiner Zachary A. Davis	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 December 2005 has been entered.
2. By the above submission, Claim 9 has been amended. Claims 1-8 and 14-26 have been canceled. No new Claims have been added. Claims 9-13 are currently pending in the present application.
3. The applicant is reminded that claim text of canceled claims is not to be presented. See 37 CFR 1.121(c)(4)(i); see also 37 CFR 1.121(c)(1).

### ***Response to Arguments***

4. Applicant's arguments filed 07 December 2005 have been fully considered but they are not persuasive.

Claims 9-11 and 13 were rejected under 35 U.S.C. 102(b) as anticipated by Wasilewski, US Patent 5420866. Claim 12 was rejected under 35 U.S.C. 103(a) as unpatentable over Wasilewski in view of McClellan et al, US Patent 5619250.

In reference to the above rejections, and in particular with reference to independent Claim 9, Applicant argues that the claim as amended "clearly recites a multi-tiered process involving multiple conditional receivers that is not anticipated" by Wasilewski. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a multi-tiered process") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, the Examiner believes that Wasilewski still anticipates Claim 9 as amended. Specifically, Claim 9 recites, for the first receiver, authorizing the receiver to use a video stream, receiving authorization at the receiver, checking if the receiver is authorized to receive the message, and blocking or allowing receipt of the message based on the result of the check. This reads on Wasilewski's disclosure of generating the entitlement management message (EMM) for the receiver (see Wasilewski, column 11, lines 43-63), receiving the EMM at the receiver (see column 14, lines 58-68), and thereafter checking the EMM information at the receiver to verify if the receiver can access a particular elementary stream (column 14, line 68-column 15, line 6), where the elementary stream could include the claimed message, i.e. other data (column 1, lines

27-35). Further, Wasilewski discloses performing the above process for multiple receivers (for example, column 6, lines 38-43). For the above reasons, the Examiner believes that Wasilewski does recite a process involving multiple conditional access receivers.

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitations of "blocking receipt of the message with the first conditional access receiver based, at least in part, upon the determining if the first conditional access receiver is authorized" and "receiving the message with the second conditional access based, at least in part, upon the determining if the second conditional access receiver is authorized". The phrases "based, at least in part, upon" are not clear because the claim does not set forth a reasonable basis for determining what else the blocking or receiving could be based upon in addition to the recited determinations. This renders the claims indefinite.

Claims 10-13 are rejected due to their dependence on a rejected base claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 9-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasilewski, US Patent 5420866.

In reference to Claim 9, Wasilewski discloses a method for distributing a message and a video stream in a conditional access system including receiving the video stream at a first receiver (column 13, line 60-column 14, line 4, for example), generating a first authorization for use of the video stream by the first receiver (column 14, line 68-column 15, line 6), receiving the first authorization information at the first receiver (column 14, lines 33-37), performing a first determination testing if the first receiver is authorized to receive the message (column 14, lines 62-65), receiving authorization information at a second receiver (column 14, lines 33-37; see also column 6, lines 38-43, where there are multiple receivers/decoders in multiple locations), performing a second determination testing if the second receiver is authorized to receive the message (column 14, lines 62-65; see also column 6, lines 38-43), blocking receipt of the message in the first receiver if the first receiver is not authorized (column

Art Unit: 2137

14, line 68-column 15, line 6, where if a receiver is authorized, the program is output), and receiving the message in the second receiver if the second receiver is authorized (column 14, line 68-column 15, line 6).

In reference to Claim 10, Wasilewski further discloses ignoring a portion of a datastream associated with the message (column 13, lines 60-63, where only some of the packets are extracted).

In reference to Claim 11, Wasilewski further discloses that determining if the first receiver is authorized includes determining entitlement for the message (column 14, lines 62-65, where the EMM is an Entitlement Management Message).

In reference to Claim 13, Wasilewski further discloses checking authorization within the first receiver (column 14, lines 62-65).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski in view of McClellan et al, US Patent 5619250.

In reference to Claim 12, Wasilewski discloses everything as applied to Claim 9 above. However, Wasilewski does not specifically disclose that the message includes a

software program. In reference to Claim 12, McClellan discloses a system for television system set top boxes that includes receiving a software module sent from a central system in a set top box (column 7, lines 23-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the methods of Wasilewski to include sending software programs in the conditional access system, in order to allow for software modules to be downloaded after the system has been initialized and to be functional upon receipt without the need for restarting the system (see McClellan, column 5, lines 10-14).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*zad*  
zad

*E. L. Moise*  
**EMMANUEL L. MOISE**  
**SUPERVISORY PATENT EXAMINER**